

**REMARKS**

The Office action mailed on 19 June 2003 (Paper No. 6) has been carefully considered.

Claims 13 and 27 are being canceled without prejudice or disclaimer, and claims 2 thru 12, 14, 16 thru 26 and 28 are being amended. Thus, claims 1 thru 12, 14 thru 26 and 28 are pending in the application.

In paragraph 1 of the Office action, the Examiner objected to claim 6 for alleged informality, that is, redundancy with respect to claim 3. Accordingly, claim 6 has been amended to depend from claim 1, thereby eliminating any redundancy.

In paragraph 3 of the Office action, the Examiner rejected claims 12 and 26 under 35 U.S.C. §102 for alleged anticipation by Kuroda, Japanese Patent Publication No. 11-268367. In paragraph 5 of the Office action, the Examiner rejected claims 1 thru 9 and 15 thru 23 under 35 U.S.C. §103 for alleged unpatentability over Maenozono, Japanese Patent Publication No. 08-127159 in view of Kuroda '367. For the reasons stated below, it is submitted that the invention recited in the claims, as now amended, is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §102 or §103.

In paragraph 6 of the Office action, the Examiner indicated that claims 10, 11, 13, 14, 24, 25, 27 and 28 recited allowable subject matter, and were merely objected to for dependency upon a rejected base claim. Accordingly, dependent claims 13 and 27 are being canceled without prejudice or disclaimer, and their recitations are being incorporated by amendment into independent claims 12 and 26, respectively. The dependency of further dependent claims 14 and 28 is being adjusted accordingly. Accordingly, it is submitted that independent claims 12 and 26 and associated dependent claims 14 and 28, respectively, are now in condition for allowance.

With respect to independent claims 1 and 15, in paragraph 5 of the Office action, the Examiner alleged that Maenzono '159 discloses a method comprising the determining, outputting and inputting and storing steps recited in claim 1, and the determining means, outputting means, inputting means and storing means recited in independent claim 15. In support of that allegation, the Examiner merely cited columns 2-3 of Maenzono '159.

Maenzono '159 discloses a printing position adjusting device for a printer, the purpose of which is to "prevent a hole for filing from entering a document (printing range) by moving a printing position by the distance corresponding to the blank of printing paper generated at the time of contraction printing" (quoting from the Abstract of Maenzono '159). Columns 2 and 3 (cited by the Examiner) encompass paragraphs

[0006] thru [0015] of Maenzono '159. A review of the translation of those paragraphs reveals that they disclose a printer having means for carrying out reduction printing of a document set as a specific paper size (*see* paragraph [0006] of Maenzono '159). An embodiment of the adjusting device for a printer of Maenzono '159 is disclosed in Figure 1, as described in paragraphs [0007] thru [0009] of the patent. A functional block diagram of the embodiment is disclosed in paragraphs [0011] thru [0015] of the patent, and the advantageous results of the invention are disclosed in paragraph [0006] of the patent.

A review of the aforementioned paragraphs of Maenzono '159 fails to reveal a complete disclosure of the determining step and means, outputting step and means, inputting step and means and storing step and means of the method and apparatus of the present invention, as recited in independent claims 1 and 15, respectively. Furthermore, in rejecting independent method claim 1, the Examiner has not cited in the Office action any specific portions of the text of Maenzono '159 which disclose the determining, outputting, inputting and storing steps, respectively, of independent method claim 1, and the Examiner has not cited any specific elements of the print adjusting device of Maenzono '159 corresponding to the specifically recited determining means, outputting means, inputting means and storing means set forth in independent apparatus claim 15. Thus, the Examiner has not set forth on the record any specific evidence to the effect that Maenzono '159 discloses or suggests the various steps of independent method claim 1

and the various means of independent apparatus claim 15.

At the bottom of page 3 of the Office action, the Examiner admits that Maenozono '159 does not disclose the step or means for "storing the inputting print location information" as recited in claims 1 and 15. As a result, the Examiner cites Kuroda '367 as allegedly teaching the step and means in question. However, the Examiner does not state where, in Maenozono '159, one of ordinary skill in the art would find the instruction or suggestion necessary in order to motivate the person of ordinary skill in the art, upon reviewing Maenozono '159, to seek the disclosure of Kuroda '367 and incorporate its disclosure into modification of Maenozono '159. It is submitted that the only reason the Examiner has been able to combine the two references under 35 U.S.C. §103 is that the Examiner has had the benefit of reviewing the subject matter of the present application, and he has exercised improper hindsight in combining those references. It is well established in patent practice and law that, in order to make a proper rejection under 35 U.S.C. §103, there must be some evidence on the record to indicate that a person of ordinary skill in the art, upon reviewing the primary reference, would be motivated by that reference to seek and incorporate the disclosure of a secondary reference in order to modify the disclosure of the primary reference. That requirement has not been satisfied in connection with the current rejection of independent claims 1 and 15 under 35 U.S.C. §103.

With respect to dependent claims 3, 6, 17 and 20, on page 4 of the Office action, the Examiner cites Figures 1 and 2, column 2, lines 43 ff. (that is, paragraphs [0011] and [0012] of Maenzono '159) as allegedly disclosing a print location menu screen including a cursor window input means for setting the default printing position information. However, a review of Figures 1 and 2 and the aforementioned paragraphs of Maenzono '159 fails to disclose such a print location menu screen including a cursor window input means, as alleged by the Examiner. It is requested that, if the Examiner is going to maintain this rejection of dependent claims 3, 6, 17 and 20, the Examiner set forth in a future Office action specific identification (preferably, by reference numeral) of the element or elements in Figures 1 and 2 of the reference corresponding to the print location menu screen and the cursor window input means.

With respect to dependent claims 4, 7, 18 and 21, on page 4 of the Office action, the Examiner cites Figures 1, 3, 4 and 16, as well as column 3 (paragraphs [0012]-[0015] of Maenzono '159) as allegedly teaching or disclosing the print location setting menu screen being programmed "such that edge boundary screen information (12) for a printing medium and print boundary screen information (13) for a print location are for printing on the medium are displayed together" (quoting from the fourth paragraph on page 4 of the Office action). However, a review of the portions of Maenzono '159 cited by the Examiner fails to reveal the recited elements. In particular, element 13 of Maenzono '159 is defined as a "range which can be printed" but does not specifically mention or

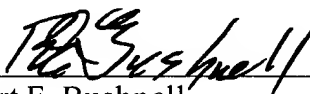
refer to “print boundary screen information”.

With respect to dependent claims 5, 8, 19 and 22, the Examiner cites Figures 1, 3, 4 and 16, as well as columns 2-3 (paragraphs [0006]-[0015] of Maenzono ‘159) as allegedly disclosing a print location setting menu screen which is programmed such that the print boundary screen is changed in the horizontal and vertical direction “by using a print location adjustment cursor (3)” (quoting from the last two lines on page 4 of the Office action). However, a review of Maenzono ‘159 reveals that element 3 of the patent is defined as a “direction switch”, and thus does not define element 3 as a “print location adjustment cursor” as alleged by the Examiner.

Finally, with respect to dependent claims 9 and 23, the Examiner admits that Maenzono ‘159 does not disclose the print location information and margin information being transmitted from a computer, but the Examiner cites Kuroda ‘367 as containing that disclosure. However, the Examiner does not cite where, in Maenzono ‘159, the person of ordinary skill in the art would receive the instruction necessary to motivate that person to seek the disclosure of Kuroda ‘367 and incorporate it in order to modify the disclosure of Maenzono ‘159. As mentioned above, in the absence of such evidence on the record, the rejection under 35 U.S.C. §103 must be construed as an improper combination of references.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



Robert E. Bushnell,  
Attorney for the Applicant  
Registration No.: 27,774

1522 "K" Street N.W., Suite 300  
Washington, D.C. 20005  
(202) 408-9040

Folio: P56417  
Date: 9/19/03  
I.D.: REB/JGS